REMARKS

Claims 1-18 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 3-7, 9-13, and 15-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by "Microsoft Device Driver for Symbios Logic ATA/ATAPI-to1394 Controller Included in Microsoft's New NT5 Beta DDK Realse, 10/6/1997," (hereafter referred to as Microsoft '997). This rejection is respectfully traversed.

First, claim 1 requires "providing the host apparatus with at least one integrated circuit chip … having an interface arranged to convert commands received from the command bus in a format in accordance with said one of the ATA/IDE standard and the Serial ATA standard into a format in accordance with said one of the IEEE 1394 standard and the Universal Serial Bus standard."

In contrast, Microsoft '997, third paragraph, second sentence, reads "The SYM13FW500 controller accepts native 1394 commands and translates them to ATA/ATAPI commands." In other words, the SYM13FW500 does not convert commands in ATA/IDE standard or Serial ATA standard into commands in IEEE 1394 standard and the Universal Serial Bus standard as required by claim 1 (the SYM13FW500 controller rather translates commands in the opposite direction).

Second, claim 1 recites "at least one integrated circuit chip connected to the command bus and to the external databus and having an interface arranged … to transmit the converted commands over the external databus."

Applicant submits that one of ordinary skill in the art would appreciate that in communication between a host apparatus and a storage medium device in accordance with either the ATA/IDE standard or the Serial ATA standard, the transfer of commands is unidirectional, while the transfer of data is bidirectional. In other words, commands are transmitted only from the host apparatus to the storage medium device. Commands are not transmitted from the storage medium device to the host apparatus. This is an express part of the ATA/IDE standard and the Serial ATA standard. As such, the host apparatus controls the storage medium device and not vice versa. Thus, one of ordinary skill in the art would appreciate that the converted commands are transmitted over the external data bus to, for example, a storage medium device. In other words, claim 1 requires an integrated circuit chip having an interface provided on the upstream side of the external databus.

In contrast, the Microsoft '997 press release regarding the SYM13FW500 controller made by Symbios Logic, Inc., states in the first paragraph, that "the SYM13FW500 controller ... is a fully integrated single-chip solution that includes an integrated controller and PHY (physical interface)." In other words, the SYM13FW500 controller at best appears to be a chip that is to be included in the storage medium device on the downstream side of the external IEEE 1394 databus.

Microsoft '997, third paragraph, last sentence, reads "Any ATA or ATAPI device can be made to look like a native 1394 SBP-2-compatible device through use of this

native 1394-to-ATA/ATAPI bridge." As such, the SYM13FW500 controller is arranged in the storage medium device on the downstream side of the external IEEE 1394 databus.

Further, Microsoft '997, fourth paragraph, second sentence, reads "Now, peripheral and system vendors using the ATA/ATAPI interface have an immediate and no-risk solution for adding 1394 solutions ...." In other words, the SYM13FW500 controller is incorporated in a "peripheral" that has an ATA/ATAPI interface, i.e. the external storage medium.

Thus, Microsoft '997 at best appears to show no more than an interface that is external to a host apparatus and at the downstream side to an external databus, rather than an integrated circuit chip having an interface provided on the upstream side of the external databus as required by claim 1.

In view of the foregoing, Applicant submits that claim 1 and its dependent claims 2-6 define over the art cited by the Examiner. Claims 7 and 13 each recite features similar to the above distinguishing features of claim 1. Thus, claim 7 and its dependent claims 8-12 as well as claim 13 and its dependent claims 14-18 define over the cited art for one or more of the reasons set forth above regarding claim 1.

REJECTION UNDER 35 U.S.C. § 103

Claims 2, 8, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "Microsoft Device Driver for Symbios Logic ATA/ATAPI-to1394 Controller Included in Microsoft's New NT5 Beta DDK Realse, 10/6/1997," (hereafter

referred to as Microsoft '997) in view of Hatano (U.S. Pub. No. 2002/0002645). This rejection is respectfully traversed.

Claims 2, 8, and 14 depend from claims 1, 7, and 13. Thus, Applicant submits that the arguments presented above regarding claim 1 apply here equally. Further, Applicant submits that Hatano fails to cure the deficiencies of Microsoft '997. As argued in the response to the previous Office action, Hatano also fails to teach or suggest an integrated circuit chip having an interface provided on the upstream side of the external databus.

In view of the foregoing, Applicant submits that claims 2, 8, and 14 define over the art cited by the Examiner.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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